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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,341	03/12/2004	Marc Husemann	tesa 1605-WCG	9929
27386	7590	05/24/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			HUANG, MEI QI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,341

Applicant(s)

HUSEMANN ET AL.

Examiner

Mei Q. Huang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10-15 and 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/03/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 1-9, 16 and 17 in the reply filed on March 29, 2005 is acknowledged. The traversal is on the ground(s) that the resulting product of inventions II and III are integral with the producing and using of the hotmelt pressure sensitive adhesive of Invention I. This is not found persuasive. The non-elected subject matter will be rejoined with the elected subject-matter upon allowance of elected subject-matter.

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

2. This Office Action is in response to the Amendment filed on February 25, 2005. Claims 1-5, 7-9, 16 and 17 are now pending. The rejection made for Claims 1, 3-9, 16 and 17 under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and the rejection made for Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (US Pub. 2003/0120101 A1) are now withdrawn in view of applicant's comments. Applicant's arguments with respect to claims 1-9, 16 and 17 have been considered but are moot in view of the new ground(s) of rejection. A new Office Action follows.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5, 7-9, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Raether et al. (U.S. Pub. No. 2003/0170306).

The prior art to Raether et al. relates to various use of a reaction product (A) which is prepared by reaction of at least one monomer (page 1, [0001]) including methyl methacrylate, etc. (page 3, [0070]). The use of the reaction product (A) includes being used as a component in pressure sensitive adhesive (page 20, [0349], page 22, [0368]). Suitable tackifiers including various adhesive resins can be seen on page 21, [0352]. Further optimum components included such as, plasticizer oil, calcium carbonate and antiaging composition, are disclosed on page 21, [0354]. Thus, all the limitations of Claims 1, 7-9, 16 and 17 are fully met by Raether et als' disclosure.

In regard to Claim 3, even though Raether et al. do not specify calcium carbonate to be chalk, one of ordinary skill in the art would have known that chalk is calcium carbonate. See "*The American Heritage College Dictionary*", page 204, wherein calcium carbonate is defined as such, "calcium carbonate is a crystalline compound, CaCO_3 , occurring naturally as chalk, and other forms". The 102 rejection over multiple

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references has been held to be proper when the extra references are cited to explain the meaning of a term used in the primary reference. *In re Baxter Travenol Labs.*, 952 F.2d 388.21 USPQ2d 1281 (Fed. Cir. 1991). See MPEP §§ 2131.01.

In regard to Claim 5, as discussed above, the hotmelt pressure-sensitive composition prepared by Raether et al. is substantially identical to the instantly claimed composition. With regard to the Raether et al. described in Claim 5, given the substantial identity in the hotmelt PSV composition between the prior art and the present application, it is the examiner's position to believe that the prior art composition must inherently possess the same shrinkback property. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to the applicant to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596, (CCPA 1980).

In sum, all the limitations of Claims 1, 3, 5, 7-9, 16 and 17 are fully met by Raether et als' disclosure.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raether et al. (U.S. Pub. No. 2003/0170306) as applied to claim 1 above, and further in view of Yamamoto et al. (U.S. Patent No. 6,432,475).

The prior art to Raether et al. is adequately presented in paragraph 4 previously in this Office Action and is incorporated herein by reference. Raether et al. do not teach the molecular weight of the polyacrylate. The prior art to Yamamoto et al. relates to adhesive composition comprising a crosslinked polymer obtained by crosslinking a block copolymer comprising at least two of a styrene-based polymer block A and an acrylic polymer block B (Abstract). Yamamoto et al. teach that the block copolymer has a number average molecular weight of preferably 10,000-200,000, from the standpoint of pressure-sensitive adhesive properties and coatability (column 6, line 38-42). Yamamoto et al. herein expressly disclose a suitable molecular weight range for a adhesive composition comprising acrylic polymer. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the molecular weight, as taught by Yamamoto et al., for Raether et al.'s polyacrylate to prepare the hotmelt pressure-sensitive adhesive in order to improve the hotmelt

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pressure-sensitive adhesive's properties and coatability as taught by Yamamoto et al. (column 6, line 38-42).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raether et al. (U.S. Pub. No. 2003/0170306) in view of Hirasawa (JP-2001262105, translation).

The prior art to Raether et al. is adequately presented in paragraph 4 previously in this Office Action and is incorporated herein by reference. Raether et al. include calcium carbonate as a filler in the pressure-sensitive adhesive formulation but do not teach the amount. The prior art to Hirasawa relates to a pressure-sensitive adhesive composition characterized by compounding 100 parts by weight of styrene methyl methacrylate graft copolymer natural rubber-based adhesive with 5 to 25 wt% of colloid fine particles, such as calcium carbonate and the pressure-sensitive adhesive has excellent flexibility and water resistance of an inkjet ink (Abstract). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the amount of the filler, as taught by Hirasawa, in Raether et al.'s hotmelt pressure-sensitive adhesive formulation, in order to improve the adhesive composition flexibility as taught by Hirasawa.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raether et al. (U.S. Pub. No. 2003/0170306) in view of Petrie "*Handbook of Adhesives and Sealants*" and further in view of Massow et al. (U.S. Patent No. 5,194,455).

The prior art to Raether et al. is adequately presented in paragraph 4 previously in this Office Action and is incorporated herein by reference. Raether et al. include calcium carbonate as a filler in the pressure-sensitive adhesive formulation but do not teach the amount and do not teach the benefit of including such filler.

The prior art to Massow et al. provides an acrylate-based hotmelt pressure sensitive adhesive comprising 55 to 98% by weight of acrylic alkyl ester (column 3, line 42-46). Massow et al. further disclose that the adhesive composition can contain additives and auxiliaries, such as antioxidants, sensitizers for UV crosslinking, fillers (for example 0.1 – 50%), see column 4, line 35-41.

Petrie, in *"Handbook of Adhesives and Sealants", Chapter 9, "Adhesive Composition and Formulation"*, teaches the various components that constitute an adhesive formulation including fillers (page 320). Petrie further teaches that by selective use of fillers, the properties of an adhesive can be changed significantly and that thermal expansion, electrical and thermal condition, shrinkage, viscosity, and thermal resistance are only a few properties that can be modified by use of fillers (page 323).

In light of Massow et als' teaching of the amount for a filler used in an acrylate-based hotmelt pressure-sensitive adhesive formulation and Petrie's teaching of the benefits of including a filler in an adhesive, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the amount of the filler, as taught by Massow et al., in Raether et als' hotmelt pressure-sensitive adhesive formulation, in order to improve the adhesive properties, such as thermal expansion,

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electrical and thermal condition, shrinkage, viscosity, and thermal resistance, as taught by Petrie as discussed above.

Priority

10. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on March 18, 2003. It is noted, however, that applicant has not filed a certified copy of the 103 12 062.9 application as required by 35 U.S.C. 119(b).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mei Q. Huang whose telephone number is (571) 272-3549. The examiner can normally be reached on 8am - 4pm, Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

**TATYANA ZALUKAEVA
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Tatyana', with a long, sweeping horizontal line extending to the right.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mei Q. Huang
Examiner

May 18, 2005